

### REMARKS/ARGUMENTS

The Examiner is thanked for the performance of a thorough search.

By this amendment, Claims 1, 3, 4, 11, 14, and 16-26 are amended, Claims 2 and 15 are cancelled, and no claims are added. Hence, Claims 1, 3-14, and 16-26 are pending in the application. Claims 1 and 14 are amended to incorporate, respectively, the subject matter of Claims 2 and 15.

#### **I. SUMMARY OF THE REJECTIONS/OBJECTIONS**

Claims 1, 5-8, 11-14, 18-21, and 24-26 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,896,491 issued to Englefield ("*Englefield*"). This rejection is respectfully traversed.

Claims 2-4, 9, 15-17, and 22 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Englefield* in view of U.S. Patent No. 6,956,593 issued to Gupta et al. ("*Gupta*"). This rejection is respectfully traversed.

Claims 10 and 23 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Englefield*. This rejection is respectfully traversed.

#### **II. THE REJECTIONS BASED ON THE CITED ART**

##### **A. CLAIM 1**

The subject matter of original Claim 2 is incorporated into Claim 1. Present Claim 1 now recites:

A method of depicting a plurality of items and how said plurality of items satisfy multiple criteria, the method comprising the computer-implemented steps of:  
**a browser receiving a self-contained page; and**  
**in response to executing said self-contained page, said browser performing the steps of:**

generating a display of a list of visual indicators in a particular order, wherein the particular order indicates how said plurality of items satisfy a first criteria;  
detecting input indicating the selection of a second criteria;  
in response to detecting said input, determining, **without said browser having to interact over a network with a server**, how said plurality of items satisfy the second criteria; and  
while retaining said list of visual indicators in said particular order within said display, displaying a visual indication of how said plurality of items satisfy the second criteria. (emphasis added)

At least the above-bolded features of Claim 1 are not taught or suggested by the cited art.

*1. Englefield and Gupta fail to teach or suggest the subject matter of Claim 2 that is incorporated into Claim 1*

The Office Action concedes that “Englefield fails to disclose a method wherein the page is self-contained” (page 7). The Office Action then cites col. 12, lines 3-22 of *Gupta* for disclosing “a browser receiving a self-contained page” as recited in original Claim 2 (now incorporated into Claim 1). This is incorrect. Col. 12, lines 3-22 states in its entirety:

The interface module 152 is an application program (or part of an application program) that is executed at client 15. **The interface module 152 may be incorporated into the web browser, operating system, or run as part of a separate, self-contained application** which can be stored locally at client 15 or alternatively received from a remote server (e.g., web page server 12 of FIG. 1) for execution at client 15. In any case, the interface module 152 operates in a graphical user interface windowing environment such as provided by the “Windows” brand of operating systems, available from Microsoft Corporation of Redmond, Wash.

Discussion is made herein of a user selecting or actuating graphical buttons or boxes, selecting menu or list options, etc. The user can perform such selection or actuation via any of a variety of conventional UI actuation mechanisms, such as using a cursor control device to position a pointer over the option or button to be selected or actuated and “clicking” on a button of the cursor control device, by tabbing (or using arrow keys) to the desired option or button and hitting the “enter” key on an alphanumeric keyboard, etc. (emphasis added)

Claim 1 requires a browser receiving and executing a self-contained page. It appears that the Office Action equates the self-contained application of *Gupta* with the self-contained page of Claim 1. This is clearly incorrect. An application is not a page.

The Office Action also cites Figures 12-14 of *Gupta* for disclosing “wherein the steps are performed by said browser in response to executing said self-contained page, without said browser having to interact over a network with a server to determine how said plurality of items satisfy said second condition” as recited in original Claim 2 (now incorporated into Claim 1).

This is incorrect.

- 1) “FIG. 12 shows a ‘query annotations’ dialog box 370 that results from a user selecting query button 262 of FIG. 6” (col. 15, lines 39-41);
- 2) “FIG. 13 shows another exemplary ‘query annotations’ dialog box 410. Dialog box 410 is similar to dialog box 370 of FIG. 12, but is a reduced option box” (col. 17, lines 7-9); and
- 3) “FIG. 14 shows another exemplary ‘query annotations’ dialog box 420. Dialog box 420 includes much of the same information and fields for querying annotations as dialog box 370 of FIG. 12. However, the information and fields are arranged differently in dialog box 420” (col. 17, lines 26-30).

Each of these figures (and the accompanying text) fails to teach or suggest that a browser executes a self-contained page, much less that a browser makes a determination, without having to interact with a server over a network, about how a plurality of items satisfy second criteria. Instead, the options and fields presented to a user in the dialog boxes of Figures 12-14 “are used as search criteria” (col. 15, lines 41-44). In order to determine how annotated media content satisfy the search criteria (i.e., the alleged second criteria) entered in dialog box 370 of FIG. 12, the user selects query button 406 of dialog box 370. In response, interface module 152 forwards the search criteria to an annotation server 10, which is over network 16 (col. 17, lines 1-4; FIGs. 1 and 3). Thus, the interface module 152 (i.e., the alleged browser) of *Gupta* must interact with a server over a network to determine which media content satisfy the search criteria, which is in contradiction to what Claim 1 would require.

Ultimately, like *Englefield*, *Gupta* also fails to teach or suggest a browser that executes a self-contained page and that the browser makes a determination, without having to interact over a network with a server, about how a plurality of items, indicated by visual indicators that the browser displays, satisfy certain criteria. Thus, even if one of ordinary skill in the art would combine *Englefield* and *Gupta*, such a combination would still fail to teach or suggest these features of Claim 1.

Based on the foregoing, *Englefield* and *Gupta* fail to teach or suggest, both individually and in combination, all the limitations of present Claim 1. Therefore, present Claim 1 is patentable over *Englefield* and *Gupta*. Reconsideration and withdrawal of the rejection of present Claim 1 is therefore respectfully requested.

2. *One of ordinary skill in the art would not combine Englefield and Gupta*

Regardless of whether *Englefield* and *Gupta* individually teach or suggest all the features of Claim 1, one of ordinary skill in the art would not combine *Englefield* and *Gupta*. After citing *Gupta* for disclosing the features of original Claim 2, the Office Action asserts, “Therefore, it would have been obvious to an artisan at the time of the invention to combine the teaching of *Gupta* with the method of *Englefield*. Motivation to do so would have been to provide a flexible application able to run on multiple environments” (page 7; emphasis added). This is incorrect. MPEP § 2143.01(IV) requires “some objective reason to combine the teachings of the references.” There is no reason to combine *Englefield* and *Gupta* because, other than depicting GUIs, they are completely unrelated to each other. *Englefield* teaches a system and method for a user to select (a) an icon that represents an operation and (b) multiple data items, after which the operation is applied to the data items. *Gupta* teaches a system for creating and viewing annotations for media content, such as audio or video.

Furthermore, the alleged motivation provided in the Office Action does not make sense. To what “flexible application” is the Office Action referring? In what way does the interface module 152 (or any other application) of *Gupta* make the data processing system of *Englefield* more flexible, or vice versa? Also, to what multiple environments is the Office Action referring? What’s more, the alleged motivation is so generic that, if found sufficient, could be used to combine any two software-related publications. Ultimately, the Office Action fails to articulate a sufficient reason why one of ordinary skill in the art would combine *Englefield* and *Gupta*.

#### B. CLAIM 11

In rejecting independent Claim 11, the Office Action states, “Claim 11 is similar in scope to that of claim 1, and is therefore rejected under similar rationale.” Simply because Claims 1 and 11 have similar scope does not mean that Claims 1 and 11 have identical scope. In fact, Claim 11 includes **numerous features** that are absent from Claim 1, such as a page, a browser, and the steps of generating first, second, and third page elements that cause or enable the browser to perform a function. The Office Action fails to cite any portion of *Englefield* for disclosing these features of Claim 11 that are not found in Claim 1. Indeed, *Englefield* fails to teach or suggest any of these features of Claim 11 that are not found in Claim 1.

In an Office Action “the particular part relied on must be designated as nearly as practicable ....” (37 C.F.R. § 1.104, MPEP § 707). The failure to specify any specific part of *Englefield* that correlates to multiple elements in Claim 11 is tantamount to admitting that *Englefield* fails to teach all the limitations of Claim 11. Reconsideration and withdrawal of the rejection of Claim 11 is therefore respectfully requested.

If the Examiner intends to issue another Office Action, that Office Action should be non-final so as to enable the Applicant an opportunity to respond and, if required, amend Claim 11.

C. CLAIMS 14 AND 24

Independent Claims 14 and 24 are computer-readable medium claims that recite the features of Claims 1 and 11 that render Claims 1 and 11 patentable over *Englefield* and *Gupta*. Thus, each of Claims 14 and 24 is patentable over *Englefield* and *Gupta* for the same reasons given above with respect to Claims 1 and 11.

D. REMAINING CLAIMS

Claims 3-10, 12-13, 16-23, and 25-26 are dependent claims, each of which depends (directly or indirectly) on the claims discussed above. Each of Claims 3-10, 12-13, 16-23, and 25-26 is therefore allowable for the reasons given above for the claim on which it depends. In addition, each of Claims 3-10, 12-13, 16-23, and 25-26 introduces one or more additional limitations. However, due to the fundamental differences already identified, to expedite the positive resolution of this case, a separate discussion of those limitations is not included at this time. The Applicant reserves the right to further point out the differences between the cited art and the novel features recited in the dependent claims.

1. *Claims 10 and 23 – Official Notice*

In rejecting Claims 10 and 23, the Office Action states, “Official notice is taken that it is notoriously well known that added a third criteria would have been an obvious variation and would yield predictable results” (page 8; emphasis added). This Official Notice is inappropriate. As MPEP § 2144.03(A) points out, “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts

asserted to be well known are not capable of instant and unquestionable demonstration as being well-known" (emphasis in original). The recited statement in the Office Action is a legal conclusion of obviousness, **not a fact that can be instantly and unquestionably ascertained**. The determination of a person of ordinary skill in the relevant art is itself a legal question **not capable** of instant and unquestionable demonstration. Furthermore, what constitutes something obvious – to a person of ordinary skill – is another legal question **not capable** of instant and unquestionable demonstration. Legal questions such as these are incapable of being directly taken as facts by the Official Notice.

In fact, the Federal Circuit has explicitly held that what is "basic knowledge" or "common sense" to *one of ordinary skill in the art* without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection. *In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (emphasis added).

Therefore, it is respectfully submitted that the assertion made by the Office Action of having taken the Official Notice is mistaken and inappropriate.

In addition to requesting for reconsideration of the Official Notice in light of the reasons set forth above, Applicants respectfully request that the Office cite a reference where the facts asserted in the Official Notice can be instantly and unquestionably demonstrated.

### III. CONCLUSION

For the reasons set forth above, it is respectfully submitted that all of the pending claims are now in condition for allowance. Therefore, the issuance of a formal Notice of Allowance is believed next in order, and that action is most earnestly solicited.

The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application.

Please charge any shortages or credit any overages to Deposit Account No. 50-1302.

Respectfully submitted,

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